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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,216	01/29/2002	Dimitris K. Agrafiotis	30923-709.501	3315
21971	7590	11/17/2004		
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 943041050			EXAMINER MAHATAN, CHANNING	
			ART UNIT	PAPER NUMBER

1631

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/058,216	Applicant(s) AGRAFIOTIS ET AL.	
	Examiner Channing S Mahatan	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004 and 04 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>04 November 2004</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

APPLICANTS' ARGUMENTS

Applicants' arguments, filed 04 August 2004, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

CLAIMS UNDER EXAMINATION

Claims herein under examination are claims 1-33 and 36. Claims 34, 35, and 37 have been cancelled.

INTERVIEW SUMMARY

Applicants' Representative, Aubrey A. Haddach, on 04 November 2004 (refer to 'Interview Summary') indicated to the Examiner the term "coordinates" in claim 24 was inadvertently lined through. The Examiner acknowledged this inadvertent amendment and indicated that instant claim 24 will be objected until the claim is amended to reflect this inadvertent line through.

Claims Rejected Under 35 U.S.C. § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33 and 36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

VAGUE AND INDEFINITE

Claims 1, 4, 16, 26, 36, and all claims dependent therefrom recites the language “relationship” which is considered vague and indefinite. For example, claim 1 recites “wherein the distances between the mapping coordinates represent relationships between the products”; it is unclear what relationships between the products is represented by the distance between the mapping coordinates. In another example, claim 4 recites “determining a relationship between the two products”; it is unclear what relationship between the two products is to be determined. Clarification of the metes and bounds, via clearer claim language, is requested.

Claims 4, 16, 26, and 36 recite the step of “repeating steps (1)(b) and (1)(c) for additional products”/ “means for continuously selecting two products at a time and refining the mapping coordinates of at least one product selected”/ “a procedure that enables said processor to continue selecting two products at a time and refining the mapping coordinates of a least one product selected”/ “repeating steps (b) and (c) for additional pairs of products” which is considered vague and indefinite. For example, it is unclear the number of times said repeating step is to be performed and/or when the steps are considered to be completed (i.e. via a criteria). Clarification of the metes and bounds, via clearer claim language, is requested.

Claim 10, 11, 20, 21, 30, and 31 recite the limitation “fragments of reagents” which is considered vague and indefinite. The language above, as previously indicated, implies a range or criteria that would define what is considered to be a fragment(s) of reagent(s). Clarification of the metes and bounds, via clearer claim language, is requested.

Claims Rejected Under 35 U.S.C. § 102

The rejection of claims 1-3, 5-9, 12, 14, 15, 17-19, 22, 24, 25, and 27-29, and 32 are rejected under 35 U.S.C. § 102(a) as being anticipated by Agrafiotis et al. (Nonlinear Mapping Networks. J. Chem. Inf. Comput. Sci. Nov.-Dec. 2000, Vol. 40, p.1356-1352) is maintained for reasons of record.

Applicants have submitted a declaration under 37 C.F.R. 1.132 to overcome this rejection, however, this insufficient (Refer to below).

DECLARATION UNDER 35 C.F.R. § 1.132

The declaration under 37 C.F.R. § 1.132 filed 04 August 2004 is insufficient to overcome the rejection of claims 1-3, 5-9, 12, 14, 15, 17-19, 22, 24, 25, and 27-29, and 32 based upon Agrafiotis et al. (Nonlinear Mapping Networks. J. Chem. Inf. Comput. Sci. Nov.-Dec. 2000, Vol. 40, p.1356-1352) applied under 35 U.S.C. § 102(a) as set forth in the last Office action because:

- a. The applied 35 U.S.C. § 102(a) reference is published within one year of the claimed priority of:

- 1) Provisional Application No. 60/264,258 29 January 2001
- 2) Provisional Application No. 60/274,238 09 March 2001
- 3) C.I.P. U.S. Application No. 09/934,084 22 August 2001

- b. The inventive entity of the instant application consists of Dimitris K. Agrafiotis, Victor S. Lovanov, and F. Raymond Salemme, whereas the authors of the applied 35 U.S.C. § 102 (a) reference is only by Dimitris K. Agrafiotis and Victor S. Lovanov (i.e. "by others"; a different inventive entity).
- c. Dimitris K. Agrafiotis declared that he and the other two named inventors, Victor S. Lovanov, and F. Raymond Salemme, contributed, in whole or in part, to the subject

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matter defined in at least one claim in the application as filed and presented in Exhibit 1 (amended claims).

d. The declaration under 35 U.S.C. § 1.132 by Dimitris K. Agrafiotis fails to antedate the applied reference.

Therefore, the submitted declaration under 35 U.S.C. § 1.132 is insufficient to overcome the rejection under 35 U.S.C. § 102 (a). Applicants are directed to the following of the M.P.E.P. 2132.01 to antedate said the applied 35 U.S.C. § 102 (a) reference:

37 C.F.R. § 1.131 AFFIDAVIT CAN BE USED TO OVERCOME A 35 U.S.C. § 102(a) REJECTION

When the reference is not a statutory bar under 35 U.S.C. § 102(b), (c), or (d), Applicants can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 C.F.R. § 1.131. In re Foster, 343 F.2d 980, 145 U.S.P.Q. 166 (C.C.P.A. 1965). If the reference is disclosing Applicants' own work as derived from him or her, Applicants may submit either a 37 C.F.R. § 1.131 affidavit to antedate the reference or a 37 C.F.R. § 1.132 affidavit to show derivation of the reference subject matter from Applicants and invention by Applicants. In re Facius, 408 F.2d 1396, 161 U.S.P.Q. 294 (C.C.P.A. 1969). See M.P.E.P. § 715 for more information on when an affidavit under 37 C.F.R. 1.131 can be used to overcome a reference and what evidence is required.

ACTION IS FINAL, AS NECESSITATED BY AMENDMENT

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Channing S. Mahatan whose telephone number is (571) 272-0717. The Examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify Applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables Applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Examiner Initials: *CSM*Date: *November 12, 2004*

MPW
MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

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